



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,372	06/23/2003	Dany Berube	26448-09191	1584
758 7590 06/26/2008 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER SONNETT, KATHLEEN C				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
06/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/602,372

Applicant(s)

BERUBE ET AL.

Examiner

KATHLEEN SONNETT

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Response to Amendment

2. Applicant's amendment states that claim 17 is canceled, claims 1 and 18 are amended and claims 19 and 20 are added. However, the copy of the claims includes claim 1 currently amended and claims 2-20 cancelled. As such, only claim 1 is currently pending in this application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. (US 5,810,811) in view of Hooven et al. (US 6,517,536). Yates discloses a clamp accessory capable of having an ablation device removably positioned therein, the clamp accessory comprising a first and second elongated jaw, the first elongated jaw having a recess in an inner surface thereof adapted to slidably receive the ablation device therein, a hinge structure operably attaching the first and second jaw members for relative rotation between an open and closed configuration along an axis for selectively effecting closure of the first and second jaw members

to operatively engage the ablation device upon a target tissue disposed between the first and second jaw members, and a transmural system including at least two electrodes disposed on the inner surface of the first jaw member along the recess on opposite sides thereof (see either fig. 12 or fig. 14) and adapted to selectively transfer electrical signals therebetween through the target tissue for monitoring the transmural of an ablation lesion formed therein by the ablation device disposed within the recess of the first jaw member (col. 9 ll. 13-19, 31-45). Although Yates et al. discloses using these electrodes to ablate tissue as well as for monitoring the transmural of the ablation lesion based on tissue impedance readings, the electrodes are capable of monitoring the transmural of an ablation lesion formed by a different ablation tool by sending an electrical signal through the tissue which is monitored by the impedance indicators. It is noted that the ablation device is recited only in functional language and therefore the device of Yates et al. must only be capable of engaging an ablation device within the recess of the first jaw member to meet the limitations of the claim. Yates fails to disclose that the hinge structure allows for rotation around an axis substantially aligned with the elongated direction of the jaw members.

5. However, Hooven teaches such a configuration. In particular, the elongated jaws of Hooven turn such that they are perpendicular to the longitudinal axis of the device (figs. 28, 29). Jaws that curve away from the longitudinal axis are well known in the art and are used to improve visibility for the surgeon as well as making it easier to reach around anatomical structures to grab the desired piece of tissue. Therefore, it would have been obvious to one skilled in the art to modify the device of Yates et al. to curve the jaws as made obvious by Hooven in order to improve visibility and tissue grasping capabilities of the device. Adding a curve to the jaws of Yates et al. as taught by Hooven will result in jaws that are elongated in a

Art Unit: 3731

direction perpendicular to the longitudinal axis of the device. The rotational axis of the jaws (around the hinge) is also perpendicular to the longitudinal axis of the device.

6. **Claim 1** is also rejected under 35 U.S.C. 103(a) as being unpatentable over Balazs et al. (US 6,053,933) in view of Foley et al. (US 6,663,622) and Hooven et al. Balazs et al. discloses a clamp accessory for removable positioning therein of an ablation device, the clamp accessory comprising a first and second elongated jaw (1, 2), the first jaw (2) having a recess in an inner surface thereof adapted to slidably receive the ablation device therein, and a hinge structure operably attaching the first and second jaw members for relative rotation between open and closed configurations (figs. 1-4). Balazs et al. discloses positioning an ablation device (7) within the recess (col. 5 ll. 37-44, esp. 43-45). Balazs et al. fails to teach the following which is taught by Foley et al. and Hooven et al.

7. Foley et al. teaches including an electrode on either side of a recess through which an ablation device is passed (see fig. 1; probe 22, electrodes 16). The electrodes are advantageous because they can be used to monitor the transmural of an ablation lesion formed by the ablation instrument passed therethrough (col. 9 ll. 50-64). It would have been obvious to one skilled in the art to employ at least two electrodes disposed on either side of the recess in jaw 2 of Balazs et al. which holds an ablation device in order to be able to monitor the transmural of the ablation lesion.

8. Hooven teaches having jaws elongated in a direction aligned with the axis of rotation of the jaws about a hinge. In particular, the elongated jaws of Hooven turn such that they are perpendicular to the longitudinal axis of the device (figs. 28, 29). Jaws that curve away from the longitudinal axis are well known in the art and are used to improve visibility for the surgeon as well as making it easier to reach around anatomical structures to grab the desired piece of tissue. Therefore, it would have been obvious to one skilled in the art to modify the device of

Art Unit: 3731

Balazs al. to curve the jaws as made obvious by Hooven in order to improve visibility and tissue grasping capabilities of the device. Adding a curve to the jaws of Balazs et al. as taught by Hooven will result in jaws that are elongated in a direction perpendicular to the longitudinal axis of the device. The rotational axis of the jaws (around the hinge) is also perpendicular to the longitudinal axis of the device.

Response to Arguments

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN SONNETT whose telephone number is (571)272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 6/18/2008
/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3731